

REMARKS

Claims 34 and 36-46 were pending in this application. Claims 43-46 are hereby cancelled. No claims have been added or amended. Thus, claims 34 and 36-42 are subject to continued examination.

Nonstatutory Double Patenting Rejection

Claims 34 and 37 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8 of U.S. Patent No. 6,479,144 to Petrea et al. (Petrea hereinafter). Applicants note that the present application and the cited Petrea patent have at all times been commonly owned by the same entity. If required, upon resolution of all other issues, Applicants will be willing to provide a terminal disclaimer to obviate this rejection.

Anticipation Rejection

Claims 34, 36, and 38-46 stand rejected under 35 U.S.C. 102(b) as being anticipated by Katsura et al. (US 5,941,369). The Examiner has cited Example 1 of the reference, which discloses a polyurethane film for adhesion to a polyester carcass for use as a food-conveying belt. The antimicrobial and antifungal agent cited in this reference is bis-(2-pyridylthio-1-oxido)-zinc. The Examiner has also cited comparative Example 2, which discloses Example 1 wherein silver-

zirconium phosphate and antifungal are substituted instead in the polyurethane film.

Applicants note that MPEP § 2131 specifically states, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that this rigorous standard is not met by Katsura.

Applicants note that the resin described in Katsura is expressly taught to include a dispersing agent. Specifically, the dispersing agent is added in order to effect uniform dispersion or dissolution of the antimicrobial compound and other constituents in the resin by improving their fluidity and dispersion ability. (See Col. 5, Lines 27-30). Moreover, the specific teaching of Katsura is that the antimicrobial powder is to be of such a size as to provide uniform dispersion within the resin. (See Col. 2, Lines 58-63). Thus, in Katsura it appears that every effort is made to achieve a uniform antimicrobial dispersion.

The current Application expressly claims an extruded film comprising a silver-based inorganic antimicrobial compound in discrete areas of said film. This appears to be in clear contrast to the uniform dispersion advocated in Katsura. Thus, as best understood, Katsura does not teach every element of the claims.

Accordingly, it is submitted that the anticipation rejection should not be maintained.

Obviousness Rejections

Claims 34 and 36-46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Krall et al. (US 5,976,562) in view of JP 09002537. The Examiner has noted that "the anti-tack and cohesive properties are inherent". Applicants respectfully note that MPEP § 2112 specifically states as follows:

*the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'*

Applicants respectfully submit that the polyurethane articles cited in the references do not necessarily exhibit the anti-tack characteristic as presently claimed. It is the presence of the silver-based antimicrobial compound "in discrete areas of said extruded film wherein at least some of said antimicrobial compound is present at and extending outward from said exterior surface of said extruded film and at least some of said antimicrobial is present within said interior

of said extruded film" that yields the anti-tack properties, not the presence of the compound itself. Thus, the anti-tack properties result from particular product conditions. A finding of inherency to support an obviousness rejection cannot be based on what would result due to optimization of conditions. See, In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

Furthermore, in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In the present case it is the position of the Applicants that the Examiner has not provided such a basis. Accordingly, Applicants submit that the obviousness rejection should not be maintained.

Claims 34 and 36-46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-028797 in view of JP 09002537. The Office Action takes the position that the primary reference "teaches polyurethane film extruded with an antimicrobial agent, such as silver and antifungal agent. The film is then

coated onto a thermoplastic resin. The film has a thickness between 10-1000 microns and instant properties. The anti-tack and cohesive properties are inherent."

In addition to the arguments detailed above against the position of inherency, it is respectfully suggested that the film described as extruded on page three of the primary reference is referring to the moldings, and not to the antimicrobial polyurethane coat which is applied as a liquid. In support of this position, Applicants refer the Examiner to paragraph 19 of the cited document which reads as follows:

*The polyurethane coating in this invention can be painted as 1 liquid type or a 2 liquid type. As the method of application, a spray method, a brushing method, a immersion coating method, electrostatic spray painting, etc. are employable.*

Applicants respectfully suggest that not only is the antimicrobial polyurethane coating not extruded, but also the use of silver-based inorganic antimicrobial compounds is not taught in the primary reference at all. It is axiomatic that all elements of a claim must be taught or suggested by the prior art in order to support a *prima facia* case of obviousness. Accordingly, Applicants submit that the obviousness rejection should not be maintained.

Conclusion:

In light of the above arguments, it is respectfully submitted that the art of record does not establish a *prima facie* case of obviousness. Thus, it is submitted that all claims presently stand in condition for allowance and an action to that effect is requested at this time.

To any extent required, a request for an extension of time is hereby made. Authorization is provided to deduct any fees required for acceptance of this paper (including any extension fees) from Deposit Account 04-0500.

Should any issues remain after consideration of this Amendment, the Examiner is invited and encouraged to telephone the undersigned in the hope that such issue may be resolved in an expedient manner.

Respectfully submitted,

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Charlotte Wilson  
Agent for Applicant(s)  
Registration Number 45,224  
Telephone: (864) 503-2194